

**REMARKS**

Claims 1-15 are pending in this application. By this Amendment, claim 7 is amended. The amendments to claim 7 introduce no new matter as they serve only to better clarify the features recited in that claim. Claim 11 is provisionally withdrawn from consideration as drawn to a non-elected species. Reconsideration of the application based on the above amendments and the following remarks is respectfully requested.

**I. Applicants Request Rejoinder of Claim 11**

The Office Action, in paragraph 1, makes final the Election of Species Requirement. As such, claim 11 is provisionally withdrawn. Claim 1 is generic to all species. Applicants respectfully request that, upon the allowance of claim 1, based on the following remarks, claim 11 should be rejoined and examined.

**II. Reply to Requirement Under 37 C.F.R. §1.105**

The Office Action, in paragraphs 2-8, sets forth a Requirement for Information Under 37 C.F.R. §1.105. Specifically, Applicants are requested to provide the citation and a copy of each publication which any of the Applicants authored or co-authored, and publications describing inventions the assignee owns or that Assignee has knowledge of, which describe the claimed subject matter, specifically of a staple having a storage medium.

In reply to the Requirement for Information, Applicants searched available databases, including Assignee's earlier U.S. patent applications, for a prior art document describing the claimed subject matter of a staple having a storage medium. Applicants could, however, find no such document.

Additionally, an Assignee representative, who is in the position to know the relevant information, was queried regarding whether (a) Assignee has any co-pending related U.S. patent applications, and/or (b) whether the inventors have published any related articles or

made any related presentations regarding the subject matter. The response to this inquiry is that Assignee's representative could find no related documents or disclosures.

Applicants believe that they have fully complied with the requirements of 37 C.F.R. §§1.105 and 1.56, and that the above factual statements are a complete reply as indicated in paragraph 8 of the Office Action.

**IV. Claim 14 Is Enabled**

The Office Action, in paragraph 10, rejects claim 14 under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action asserts that claim 14 contains subject matter which was not described in the specification in such a way as to enable one of ordinary skill in the art to make and/or use the invention. This rejection is respectfully traversed, because (1) the state of the prior art, as exemplified by the attached technical publication, shows that the specification is enabling, (2) the rejection does not set forth a complete and proper analysis, and (3) Applicants' disclosure does, in fact, provide enablement in and of itself at, for example, Figs. 1A and 1B and page 9, lines 17-18 of the specification.

MPEP §2164.01, quoting *United States v. Telectronics, Inc.*, 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), states "The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation" (emphasis added). The MPEP continues "A patent need not teach, and preferably omits, what is well known in the art." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (emphasis added). The MPEP goes on to state that there are many factors to be considered

when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement, and lists eight exemplary such factors.

The Office Action includes no analysis of any factors and includes only a conclusory statement that the specification does not enable one skilled in the art to use the staple needle as an antenna. The MPEP section goes on to state that "[i]t is improper to conclude that a disclosure is not enabling based on an analysis of only one of the above factors while ignoring one or more of the others." The Examiner's analysis must consider all of the evidence related to each of the factors, and any conclusion of non-enablement must be based on the evidence as a whole. See *In re Wands*, 858 F.2d 731, 737, 740, 8 USPQ2d 1400, 1404, 1407 (Fed. Cir. 1988).

One of the factors to be analyzed is the state of the prior art. Applicants respectfully submit the attached document entitled "IC Card Application Guideline (Contact/Non-Contact) (Ver. 1.0)," dated March 1998, describing that when transmitting/receiving data while supplying power to an IC card, a small conductive coil may be used as an antenna. Even alone, but all the more so in view of this prior art disclosure showing the use of a small conductive coil as an antenna, Applicants' disclosure enables one skilled in the art to use the staple as an antenna. See, for example, Figs. 1A and 1B, which show an IC 3 attached to a staple needle 42a, and page 9, lines 17-18 of the specification, describing that "[a] portion of the staple needle 42a may function as an antenna when the IC chip 3 transmits/receives data." One skilled in the art could easily use a staple needle as an antenna when informed by this disclosure.

Accordingly, reconsideration and withdrawal of the rejection of claim 14 are respectfully requested.

If this rejection is to be maintained, then Applicants are entitled to the full analysis required by, *e.g.*, M.P.E.P. 2164.01, as set forth above, including the "undue experimentation" analysis and consideration of the eight exemplary factors listed.

**V. Claim 7 Recites Patentable Subject Matter**

The Office Action, in paragraph 11, rejects claim 7 under 35 U.S.C. §101. Specifically, the Office Action asserts that the claimed invention is directed to non-statutory subject matter because the claim encompasses a human being (user). Claim 7 is amended to obviate the rejection.

Accordingly, reconsideration and withdrawal of the rejection of claim 7 under 35 U.S.C. §101 are respectfully requested.

**VI. The Applied Prior Art Reference Is Unavailable Based On Applicants' Perfected Claim Of Priority**

The Office Action, in paragraph 13, rejects claims 1-10 and 12-15 under 35 U.S.C. §102(a) as being anticipated by JP-A-2003-212315 (hereinafter "JP 315"). This rejection is respectfully traversed.

JP 315 is not available as prior art because Applicants claim priority from Japanese Patent Application No. 2002-248786 (hereinafter "JP 786") filed on August 28, 2002, and Japanese Patent Application No 2003-169620 filed June 13, 2003, which dates are prior to the July 30, 2003 publication date of JP 315. A claim of priority was filed on August 26, 2003, and certified copies of the priority documents were submitted on January 8, 2004, in compliance with 35 U.S.C. §119. Additionally, verified English-language translations of the priority documents are attached, which include a statement that the translations are accurate.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-10 and 12-15 under 35 U.S.C. §102(a) as being anticipated by JP 315 are respectfully requested.

**VII. Conclusion**

In view of the foregoing, Applicants respectfully submit that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 1-15 are earnestly solicited.

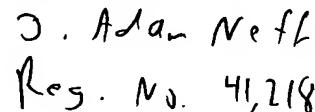
Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact Applicants' undersigned representative at the telephone number set forth below.

Respectfully submitted,



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JAO:DAT/fpw

Attachments:

Verified English-language translation of JP-A-2002-248786

Verified English-language translation of JP-A-2003-169620

Statement that the translation is accurate in compliance with MPEP §201.13

Excerpts from and selected English-language translation of excerpted portions of "IC Card Application Guide Line (contact/non-contact) (ver. 1.0)," Generation Electronic Commerce Promotion Council of Japan, pp. 95, 105 and 106 (March 1998)

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